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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,970

02/17/2004

Carl K. Esche JR.

0013.0014

9121

63970

7590

03/03/2009

MH2 TECHNOLOGY LAW GROUP (Cust. No. w/NewMarket)

1951 KIDWELL DRIVE

SUITE 550

TYSONS CORNER, VA 22182

EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,970

Applicant(s)

ESCHE ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 37-39, 42-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-34, 37-39, 42-44 is/are rejected.
- 7) ☒ Claim(s) 4, 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed 1/5/09 fail to overcome the rejections set forth in the office action mailed 9/3/08, which are maintained below.

Claim Rejections - 35 USC § 102

2. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Udelhofen.
This rejection is adequately set forth in paragraph 1 of the office action mailed 9/3/08, which is incorporated here by reference.
3. Claims 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Daly.
This rejection is adequately set forth in paragraph 2 of the office action mailed 9/3/08, which is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. Claim 1-3, 5, 8-9, 11-12, 14-16, 18-21, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamakura.
This rejection is adequately set forth in paragraph 3 of the office action mailed 9/3/08, which is incorporated here by reference.
5. Claims 24-28, 30, 32-33, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardasz in view of Kamakura.

This rejection is adequately set forth in paragraph 4 of the office action mailed 9/3/08, which is incorporated here by reference.

6. Claims 10, 17, 22, 24-30, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Kamakura.

This rejection is adequately set forth in paragraph 5 of the office action mailed 9/3/08, which is incorporated here by reference.

7. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (U.S. Pat. No. 5,286,264) in view of Kamakura.

This rejection is adequately set forth in paragraph 6 of the office action mailed 9/3/08, which is incorporated here by reference.

8. Claims 24 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (U.S. Pat. No. 5,571,445) in view of Kamakura.

This rejection is adequately set forth in paragraph 7 of the office action mailed 9/3/08, which is incorporated here by reference.

Allowable Subject Matter

9. Claims 4 and 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Kamakura only discloses a

dispersant obtained by the reaction of a hydrocarbon-substituted succinic anhydride and a treated aliphatic amine. There is no teaching or suggestion in Kamakura that would lead one of ordinary skill in the art to modify the amine of Kamakura to an aromatic amine, as recited in claim 4, or to change the succinimide product of Kamakura to a Mannich adduct or an ethylene-propylene copolymer as recited in claims 6-7. Claims 4 and 6-7 are also distinguished over the prior art discussed in previous office actions for the reasons discussed in those office actions.

Response to Arguments

10. Applicant's arguments filed 1/5/09 have been fully considered but they are not persuasive. Regarding the rejections over Udelhofen and Daly, applicant argues that the claims require treated amines, and that the references do not disclose treated amines. However, claim 37, as filed on 6/13/08, recites *untreated* amines rather than treated amines.

Regarding the rejections over Kamakura, applicant argues that the precise molecular weight of a reaction product cannot be predicted by simply adding the molecular weights of its reactants. However, one of ordinary skill in the art knows that the reaction product of a polybutenyl succinic anhydride and a polyamine will be a succinimide (such as the "polybutenyl succinic imide" of Kamakura's Example 1), with a molecular weight approximately similar to the sum of the molecular weights of the reactants. Given that the polybutenyl group alone has a molecular weight overlapping

the claimed range, the product will clearly also have a molecular weight overlapping the claimed range.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenn A Caldarola/
Acting SPE of Art Unit 1797

JCG